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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/010,317	01/21/98	HOOK	M TAMK:189

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HM12/0430

EXAMINER

WEATHERSPOON, J

ART UNIT	PAPER NUMBER
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1645

7

DATE MAILED:

04/30/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/010,317

Applicant(s)
Hook et al

Examiner
John K. Weatherspoon

Group Art Unit
1645



☒ Responsive to communication(s) filed on Jan 21, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-53 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-53 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1645

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-14, 29 (drawn to 29a), 30, 42 (drawn to 42a) and 43-50, drawn to compositions and kits comprising an antibody that binds to a fibronectin binding domain of a fibronectin binding protein, classified in class 530, subclass 387.1.

II. Claims 15-24, 29 (drawn to 29b), 31 and 42 (drawn to 42b), 47, 49 and 50, drawn to compositions and kits comprising an isolated peptide of a fibronectin binding domain of a fibronectin binding protein, classified in class 530, subclass 300.

III. Claims 25-27, drawn to compositions comprising a fusion protein, classified for example in class 530, subclass 402.

IV. Claims 28, 29 (drawn to 29c) and 42 (drawn to 42c), drawn to compositions comprising an isolated nucleic acid segment, classified in class 536, subclass 23.1.

V. Claims 32 and 38-41, drawn to method of identifying a peptide of a fibronectin binding domain of a fibronectin binding protein, and methods for detecting a fibronectin binding protein in a sample, classified in class 436, subclass 501.

VI. Claims 33-37, drawn to methods of generating an antibody that binds to a fibronectin binding domain of a fibronectin binding protein, classified in class 514, subclass 21.

Art Unit: 1645

VII. Claims 51-53, drawn to methods of preventing or treating a microbial infection in an animal comprising administration of a therapeutically effective amount of a pharmaceutical composition, classified for example in class 424, subclass 130.1.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions (I, II and IV) and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(H)). In the instant case the products claimed in Groups I, II and IV can be used in materially different methods of use (e.g. in vitro binding methods using the compositions of Groups I and II; methods of hybridization using the compositions of Group IV) which are distinct from the methods of use claimed in Group VII.

Inventions II and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the products claimed in Group II can be used in materially different methods of use (e.g. a methods for structural characterization of claimed peptide) which are distinct from the methods of use claimed in Group V.

Art Unit: 1645

Inventions I and VI are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product of Group I (i.e. antibody that binds to a fibronectin binding domain of a fibronectin binding protein) can be made by a materially different process, e.g. by recombinant means.

The claims of Groups I-IV are drawn to structurally and functionally distinct products. Group I contains claims drawn to compositions and kits comprising an antibody that binds to a fibronectin binding domain of a fibronectin binding protein. Group II contains claims drawn to compositions and kits comprising an isolated peptide of a fibronectin binding domain of a fibronectin binding protein. Group III contains claims drawn to compositions comprising a fusion protein. Group IV contains claims drawn to compositions comprising an isolated nucleic acid segment. These products are clearly distinct.

The claims of Groups V-VII are drawn to distinct methods which differ in the method objectives, steps and parameters. Group V contains claims drawn to method of identifying a peptide of a fibronectin binding domain of a fibronectin binding protein, and methods for detecting a fibronectin binding protein in a sample. Group VI contains claims drawn to methods of generating an antibody that binds to a fibronectin binding domain of a fibronectin binding protein. Group VII contains claims drawn to methods of preventing or treating a microbial

Art Unit: 1645

infection in an animal comprising administration of a therapeutically effective amount of a pharmaceutical composition. These methods are clearly distinct.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications and/or recognized divergent subject matter and because the searches required for examination of the groups identified above are not coextensive, restriction for examination purposes as indicated is proper.

4. A telephone call was made to Susie Strickland on March 23, 1999 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this restriction requirement must include an election of the invention to be examined even if election with traverse is made (see 37 CFR 1.143).

5. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology center 1600, Group 1645 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1645 is (703) 308-4242.

Art Unit: 1645

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Weatherspoon, Ph.D. whose telephone number is (703) 305-0557.

The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, Ph.D., can be reached at (703) 308-3995.

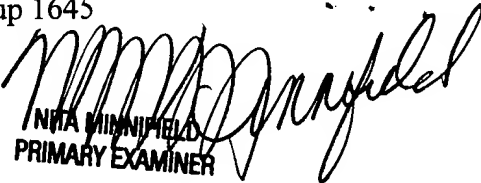
John Weatherspoon, Ph.D.

April 29, 1999

Nita Minnifield, Ph.D.

Primary Examiner

Group 1645


NITA MINNIFIELD
PRIMARY EXAMINER